

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 10/537,773

Attorney Docket No.: Q88188

AMENDMENTS TO THE DRAWINGS

Fig. 6 has been added.

Attachment: Replacement Sheet

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 10/537,773

Attorney Docket No.: Q88188

REMARKS

Summary Of The Office Action & Formalities

Status of Claims

Claims 1-3 are all the claims pending in the application. By this Amendment, Applicant is amending claims 1 and 3 and adding new claims 4-10. No new matter is added.

Additional Fees

Submitted herewith is a Petition for Extension of Time and authorization to charge a deposit account.

Claim to Foreign Priority

Applicant thanks the Examiner for acknowledging the claim to foreign priority and for confirming that the certified copy of the priority document was received.

Information Disclosure Statement

Applicant also thanks the Examiner for initialing the references listed on form PTO/SB/08 submitted with the Information Disclosure Statement filed on June 6, 2005.

Drawings

The drawings are objected to under 37 CFR 1.83(a).

The drawings must show every feature of the invention specified in the claims. Therefore, the bag or inflatable and burstable structure that is also deflatable must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Office Action at page 3. Applicant is submitting a replacement sheet that adds Fig. 6, which is believed to address this objection.

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 10/537,773

Attorney Docket No.: Q88188

Claim Objections

Claim 1 is objected to because of the following informalities: In line 4 "disk" should read

-- disks--.

Office Action at page 4. Applicant is amending claim 1 to overcome this objection.

Claim Rejections - § 112

*Claims 1-3 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with
the enablement requirement.*

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The exact structure of the invention is not clearly described in regard to the inflatable and deflatable bag which can be burst to act as an indicator of which breast is being used when breast feeding. The exact structure that bursts and how it is formed has not been clearly described.

Office Action at page 2. Applicant respectfully disagrees.

The test for resolving issues of enablement is well-established: whether one reasonably skilled in the art could make and use the invention from the disclosure in the patent coupled with information known in the art *without undue experimentation*. See, e.g., Northern Telecom v. Datapoint 15 USPQ2d 1321, 1328-30 (Fed. Cir. 1990); U.S. v. Electronics 8 USPQ2d 1217, 1222-24 (Fed. Cir. 1988). A patent document is not intended to be a production specification. Furthermore, “An inventor need not . . . explain every detail since he is speaking to those skilled in the art. What is conventional knowledge will be read into the disclosure. . . . ‘It is well settled that the disclosure of an application embraces not only what is expressly set forth in words or drawings, but what would be understood by persons skilled in the art. . . . [T]he applicant ‘may begin at the

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 10/537,773

Attorney Docket No.: Q88188

point where his invention begins, and describe what he has made that is new and what it replaces of the old. That which is common and well known is as if it were written out in the patent and delineated in the drawings.”” In re Howarth, 210 USPQ 689, 691-92 (CCPA 1981) (quoting In re Chilowsky 108 USPQ 321, 324 (1954) and Webster Loom Co. v. Higgins et al. 105 U.S. 580, 586 (1882)). In fact, “[i]n examining a patent application, the PTO is required to assume that the specification complies with the enablement provision of Section 112 unless it has ‘acceptable evidence or reasoning’ to suggest otherwise. . . . The PTO thus must provide reasons supported by the record as a whole why the specification is not enabling. . . . Then and only then does the burden shift to the applicant to show that one of ordinary skill in the art could have practiced the claimed invention without undue experimentation. . . . Gould v. Mossinghoff, 229 USPQ 1, 13-14 (D.D.C. 1985) (citations omitted), aff’d in part, vacated in part on other grounds, and remanded sub nom. Gould v. Quigg, 3 USPQ2d 1302 (Fed. Cir. 1987).

In the present application, while the presence of a bubble as a marker for a breast protection disk was not known, one skilled in the art would, nevertheless, clearly be able to make such a disk without undue experimentation. The “inflatable bubble” was conceived as a tactile marking in high relief that can be modified (e.g., bursting) so as to differentiate the disk. A set of disks provided with a mark in the form of an inflatable bubble is very useful at the moment of marking the preferred breast for the next feeding, because the mother can take two similar disks provided each with an inflatable bubble deflate or burst the bubble of the disk applied to the breast for next feeding. As an example of one such bubble that one skilled in the art could look to, after having read Applicant’s disclosure, is an air bubble made of plastic and that is found in the rolls used as

Amendment Under 37 C.F.R. § 1.111

U.S. Application No. 10/537,773

Attorney Docket No.: Q88188

a surface protection used in packaging of fragile products. Clearly, therefore, one skilled in the art would not require to carry out undue experimentation in order to make a breast protection disk having a bubble as claimed.

Accordingly, the Examiner is kindly requested to reconsider and withdraw this rejection.

Claims 1-3 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear as to what is actually being claimed since there are too many alternative embodiments in the claims. There are numerous structural combinations. Therefore it is not clear as to what exact structure is being claimed. There are multiple different inventions disclosed. One invention is the embossed exterior surface and the other being the burst able bag or inflatable structure. It has not been clearly disclosed how the burst able structure is formed as discussed above. Also, in claim 3 it is not clear as to what a "small deposit" encompasses in regard to the bag or inflatable bubble wherein the different structures may not be structural equivalents but different inventive structures.

Office Action at pages 2-3.

Applicant's amendment to claim 1 is believed to overcome this rejection. Applicant also provides the following additional clarification. Applicant's claim 1 is directed to protection disks for breastfeeding mothers wherein there are disks of two kinds clearly differentiated from each other. The differentiation between the disks of two kinds (e.g., A and B) can be as follows:

- a) the disks of kind A have an appreciably different configuration from the disks of kind B, intended for applying to the other breast. This is shown in Fig. 5 wherein the disks of different kinds have different shapes: the first kind of disks 2 have an

Amendment Under 37 C.F.R. § 1.111

U.S. Application No. 10/537,773

Attorney Docket No.: Q88188

appreciably rounded configuration, and the second kind of disks 2' have an appreciably hexagonal configuration; or

- b) the disks of kind A are provided with at least one differentiating tactile marking, in high relief or in low relief, enabling them to be differentiated from other disks of the second kind B, intended for applying to the other breast, which are devoid of said marking or have another different marking; or
- c) the disks of kind A are provided with at least one differentiating optical marking, enabling them to be differentiated from other disks of the second kind B, intended for applying to the other breast, which are devoid of said marking or have another different marking.

Allowable Subject Matter

Applicant thanks the Examiner for indicating that claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, 2nd paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.

Art Rejection

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Logue (US 6,264,529).

Applicant respectfully traverses.

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 10/537,773

Attorney Docket No.: Q88188

Claim Rejections - 35 U.S.C. § 102

Claims 1 And 2 In View Of Logue (US 6,264,529).

In rejecting claims 1 and 2 in view of Logue (US 6,264,529), the grounds of rejection state:

Logue discloses a nursing bra 40 with an absorbent disk being the bra cup (42) itself that absorbs fluid as claimed and also includes an indicator 38 that is a tactile or optical marker. Each indicator 38 is different, removable and replaceable on each separate cup or disk as broadly claimed.

Office Action at page 4. Applicant respectfully disagrees.

During examination in the USPTO, “claims . . . are to be given their broadest reasonable interpretation *consistent with the specification*, and . . . claim language should be read *in light of the specification as it would be interpreted by one of ordinary skill in the art.*” *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990) (emphasis added). Applicant respectfully submits that the grounds of rejection unfairly equate the term “disk” with a bra cup.

Logue does not refer to a “disk” and there is no suggestion that fairly would permit one to generalize the term “cup” in order to also cover “disks” as claimed, since such an interpretation would be entirely inconsistent with Applicant’s specification. A “protection disk” for breastfeeding mothers is very different from the separate “cup” of a nursing bra. According to Applicant’s invention, a “protection disk” is a breastfeeding pad, made of a highly absorbent material arranged between the breast and the inner surface of each one of the cups of a bra to absorb the flow of milk leakage and protect the breasts from knocks and chafing.

Moreover, a breastfeeding disk is a disposable product that is thrown once the absorbent material has absorbed the flow of milk which comes out from the mother’s breasts.

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 10/537,773

Attorney Docket No.: Q88188

The nursing bra according to Logue is a special bra designed for breastfeeding and which has an indicator 30 that can be alternately coupled to a selectable one of the fasteners 20 to indicate which breast is preferred for the next feeding. The breastfeeding bras are useful to facilitate the feeding of the baby because the cups are hingeably coupled so that they can be easily opened, leaving the breast accessible by the baby and avoiding having to remove the usual bra with every feeding.

However, as not all the breastfeeding bras are provided with absorbent cups (this kind of bras need to be washed frequently), it is common for mothers to place protective disks between the breasts and the inner surface of the cups. One problem for the mother is choosing a method for identifying which breast to begin with in the next feeding. The mother can purchase a special bra like the one disclosed in Logue or a set of protection disks according to claim 1 of the present application, which can be disposed of once the flow of milk is absorbed and replaced with clean new disks. With the disks as claimed in the present application, the mother does not need to worry about remembering which breast to begin with in the next feeding.

In view of the foregoing distinctions, the Examiner is kindly requested to reconsider and withdraw the rejection of claims 1 and 2.

New Claims

For additional claim coverage merited by the scope of the invention, Applicant is adding new claims 4-10, which are believed to be allowable for reasons analogous to those set forth above.

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 10/537,773

Attorney Docket No.: Q88188

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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